

REMARKS

In accordance with the foregoing, claims 1-10 are pending and under consideration.

Claims 1, 2, 4-7 and 9 are rejected under 35 USC § 103(a) as being obvious over U.S. Patent No. 6,104,454 to Hiyama et al. Claims 3, 8 and 10 are rejected as being obvious over Hiyama et al. in view of "Applicant's admitted prior art."

Independent claims 1 and 2 recite a prismatic light control element formed directly on a polarization film. The other independent claims contain similar recitations. Although the claims are not restricted what is shown in the drawings, Fig. 1 shows a prismatic light control face 21 being formed directly on a polarization film 16.

The device disclosed in Hiyama et al. does not have a prismatic light control face unified with a polarization film. For example, Fig. 12 shows a polarization film 252 separate from a prismatic light control element 240/242.

The Examiner asserts that this deficiency would have been obvious. Specifically, the Examiner asserts that it would have been obvious to form in one piece an article which has formally been formed in two pieces. The Examiner cites Howard v. Detroit Stove Works for this proposition. The Examiner states that applicants have provided no evidence to support the contention that Howard v. Detroit Stove Works is not good law.

Enclosed are two cases distinguishing Howard v. Detroit Stove Works. The first case, Pyle National Company v. Lewin states:

Appellants also advance the proposition that the mere casting together of two or more parts, which previously had been cast separately, does not constitute invention, and a number of cases are cited in support of this contention, chief of which is Howard v. Detroit Stove Works, 150 U.S. 164. This proposition, however, must be limited to cases where by such a change no new or different result is attained.

The claimed invention attains a new or different result. Specifically, the unified structure eliminates the problems described on page 3 of the application. As described beginning at page 10, line 11 of the application, the invention avoids damaging the projections of a prism sheet. This in turn avoids an abnormal image, which could occur when damaged projections are irradiated by illumination light. "In other words, the polarization film 16 and prism sheet 21 are unified to provide a unified composite optical element which is harder to be deformed as

compared with cases where they are not unified.”

The second enclosed case, General Electric Co. v. Dunkirk states:

There is an important difference between the facts of this case and those shown in Howard v. Detroit Stove Works, 150 U.S. 164, 14 Sup.Ct. 68, 37 L.Ed. 1039, cited by defendants' counsel, wherein the Supreme Court held the Beckwith patent for improvements in stoves invalid. In that case the improvement, consisting of bolting or riveting together sections of a stove, was held invalid because such manner of fastening parts was known at the time of the alleged invention, while in the case at bar, as elsewhere stated, the specific fastening means was an original adaptation.

In other words, General Electric Co. v. Dunkirk recognizes that if there is something new about the unifying two elements, which were previously separate, then there may be an invention. With the present invention the possibility of damaging prismatic projections of the prismatic light control surface is reduced. The prismatic projections are less likely to be damaged by the emission face of the light guide plate. With a configuration such as that of Hiyama et al., the two elements could easily move with respect to each other. The prismatic projections could be damaged upon scraping against the emission face of the light guide plate.

The Federal Circuit no longer relies upon old maxims of patentability such as Howard v. Detroit Stove Works. Instead, the Federal Circuit reviews each case individually, based on the three-part test set forth in Graham v. John Deere Co., 383 U.S. 1 (1966). The Examiner is respectfully requested to reconsider the rejections based on the three-part test. It is believed that the claims clearly satisfy the three-part test and are non-obvious. It is hence submitted that the rejections should be withdrawn.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/288,217

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 10-20-04